



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

28

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/955,373	10/21/1997	SOREN MOURITSEN	2473.0570003/EKS/FRC	7254

26111 7590 01/11/2007
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

SCHWADRON, RONALD B

ART UNIT PAPER NUMBER

1644

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

08/955,373

Applicant(s)

MOURITSEN ET AL.

Examiner

Ron Schwadron, Ph.D.

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 85-100 is/are pending in the application.
- 4a) Of the above claim(s) 88-100 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 85-87 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Application Number: 08/955,373

Art Unit: 1644

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/10/06 has been entered.

2. Newly submitted claims 88-100 are directed to an invention that is independent or distinct from the invention currently under examination for the following reasons. New claims 85-87 correspond to the invention elected by applicant in response to the restriction requirement of 10/30/98 (see response filed 11/30/98). Claims 88-100 correspond to nonelected inventions for essentially the reasons as elucidated in the restriction requirement of 10/30/98 with claim 98 included in Group V as per specified in said Office Action.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 88-100 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Claims 85-87 are under consideration.

4. The previously pending rejections of the claims as per enunciated in the previous Office Action are withdrawn in view of the cancellation of all previously pending claims.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Application Number: 08/955,373

Art Unit: 1644

6. Claims 85-87 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support in the specification as originally filed for the method of claim 85 wherein the limitation that the analog is made by molecular biological means is absent. The claims encompass a method wherein the molecule is made by chemical synthetic means and this is not disclosed in the specification as originally filed.

7. Claims 85-87 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not provide adequate written description of the claimed invention. The legal standard for sufficiency of a patent's (or a specification's) written description is whether that description "reasonably conveys to the artisan that the inventor had possession at that time of the . . . claimed subject matter", *Vas-Cath, Inc. V. Mahurkar*, 19 U.S.P.Q.2d 1111 (Fed. Cir. 1991). In the instant case, the specification does not convey to the artisan that the applicant had possession at the time of invention of the claimed invention.

The instant claims encompass a method that uses a mutant analogue peptide wherein the analogue peptide has a substituted foreign immunodominant T cell epitope with the functional properties recited in the claim. Whilst the specification discloses a particular example of a particular molecule with a particular substitution which apparently has the properties recite in the claims, the claims encompass a vast collection of mutant molecules with the properties recited in the claims that are not disclosed in the specification. It is unpredictable as to what particular substitutions can be made to any particular molecule and result in a mutant analogue molecule with the functional attributes recited in the claims.

Application Number: 08/955,373

Art Unit: 1644

In view of the aforementioned problems regarding description of the claimed invention, the specification does not provide an adequate written description of the invention claimed herein. See *The Regents of the University of California v. Eli Lilly and Company*, 43 USPQ2d 1398, 1404-7 (Fed. Cir. 1997). In *University of California v. Eli Lilly and Co.*, 39 U.S.P.Q.2d 1225 (Fed. Cir. 1995) the inventors claimed a genus of DNA species encoding insulin in different vertebrates or mammals, but had only described a single species of cDNA which encoded rat insulin. The court held that only the nucleic acids species described in the specification (i.e. nucleic acids encoding rat insulin) met the description requirement and that the inventors were not entitled to a claim encompassing a genus of nucleic acids encoding insulin from other vertebrates, mammals or humans, *id.* at 1240. In the instant case, the facts are similar to those disclosed in *University of California v. Eli Lilly and Co.* The Federal Circuit has held that if an inventor is "unable to envision the detailed constitution of a gene so as to distinguish it from other materials. . .conception has not been achieved until reduction to practice has occurred", *Amgen, Inc. v. Chugai Pharmaceutical Co, Ltd.*, 18 U.S.P.Q.2d 1016 (Fed. Cir. 1991). Attention is also directed to the decision of *The Regents of the University of California v. Eli Lilly and Company* (CAFC, July 1997) wherein is stated: The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736 F.2d 1516, 222 USPQ 369, 372-373 (Fed. Cir. 1984) (affirming rejection because the specification does "little more than outlin[e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate."). Accordingly, naming a type of material generally known to exist, in the absence of knowledge as to what that material consists of, is not a description of that material. Thus, as we have previously held, a cDNA is not defined or described by the mere name "cDNA," even if accompanied by the name of the protein that it encodes, but requires a kind of specificity usually achieved by means of the recitation of the sequence of nucleotides that make up the cDNA. See *Fiers*, 984 F.2d at 1171, 25 USPQ2d at 1606.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 85-87 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 85 is indefinite in the recitation of "the tertiary structure of the pathogenic self-protein is essentially preserved" because it is unclear what this means or encompasses. It is unclear what changes to the tertiary structure would or would not be encompassed by the aforementioned term. For example, it is unclear if this term encompasses changes at the physical/chemical level (eg. crystal structure) or simply functional changes (eg. still immunogenic antigen as evidenced by antibody binding by antibodies specific for unmodified antigen). If the term is interpreted as encompassing changes at the physical/chemical level, it is unclear as to what deviations from the normal crystal structure would or would not be encompassed by the term "essentially preserve the overall tertiary structure". Claim 86 is indefinite in the recitation of "preserve flanking regions" because it is unclear what this term means or encompasses. Claim 85 is indefinite in the recitation of "pathogenic self-protein" because it is unclear what this means or encompasses. Said term is not defined in the specification and has no art recognized definition. It is unclear if said term applies to mutant versions of normal proteins or normal proteins or normal proteins expressed at abnormal levels or normal proteins that contain epitopes that cross react with exogenous pathogenic proteins or combinations of the aforementioned.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 85 and 86 are rejected under 35 U.S.C. 102(b) as being anticipated by Russell-Jones et al. (WO 92/05192) as evidenced by Dean et al. (US Patent 5,716,596).

Russell-Jones et al. teach T cell epitopes derived from Trat protein (see Abstract). Russell-Jones et al. teach Trat T cell epitopes are inserted into proteins, wherein the insertion of said peptide increases the antibody response against the protein into which Trat has been inserted (see page 4, lines 24-26 and Abstract). Russell-Jones et al. teach that the Trat peptide is inserted such that the protein still functions as an immunogen. The Trat peptide has been inserted into the immunogen in such a manner as to essentially preserve the overall tertiary structure, because the ability of the immunogen to function as an immunogen is maintained (see page 8, first complete paragraph). Russell-Jones et al. teach that the Trat modified immunogen can be used as a vaccine in a composition containing an adjuvant such as saponin (see page 8 and 13). Russell-Jones et al. teach that using recombinant DNA technology that Trat peptide can be inserted into the immunogen via substituting Trat peptide for a peptide contained in said molecule (see page 32 and page 31, first incomplete paragraph). Said insertion would preserve flanking regions on both sides of the Trat T cell epitope. Russell-Jones et al. teach that immunogens used in the aforementioned vaccines can include self proteins such as luteinizing hormone, somatostatin, inhibin, FSH (see page 9 and claim 12). Russell-Jones et al. teach that such vaccines can be used in animals and humans. Whilst the term "pathogenic self protein" is indefinite, for the purposes of this rejection it will be interpreted as encompassing a normal protein related to a disease. Somatostatin is inherently a "pathogenic self protein" in view of its art recognized role in a variety of diseases (see Dean et al., column 2, first paragraph and column 6, third paragraph from bottom).

Application Number: 08/955,373

Art Unit: 1644

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 85-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell-Jones et al. (WO 92/05192) in view of Dean et al. (US Patent 5,716,596).

Russell-Jones et al. teach T cell epitopes derived from Trat protein (see Abstract). Russell-Jones et al. teach Trat T cell epitopes are inserted into proteins, wherein the insertion of said peptide increases the antibody response against the protein into which Trat has been inserted (see page 4, lines 24-26 and Abstract). Russell-Jones et al. teach that the Trat peptide is inserted such that the protein still functions as an immunogen. The Trat peptide has been inserted into the immunogen in such a manner as to essentially preserve the overall tertiary structure, because the ability of the immunogen to function as an immunogen is maintained (see page 8, first complete paragraph). Russell-Jones et al. teach that the Trat modified immunogen can be used as a vaccine in a composition containing an adjuvant such as saponin (see page 8 and 13). Russell-Jones et al. teach that using recombinant DNA technology that

Trat peptide can be inserted into the immunogen via substituting Trat peptide for a peptide contained in said molecule (see page 32 and page 31, first incomplete paragraph). Said insertion would preserve flanking regions on both sides of the Trat T cell epitope. Russell-Jones et al. teach that immunogens used in the aforementioned vaccines can include self proteins such as luteinizing hormone, somatostatin, inhibin, FSH (see page 9 and claim 12). Russell-Jones et al. teach that such vaccines can be used in animals and humans. Whilst the term "pathogenic self protein" is indefinite, for the purposes of this rejection it will be interpreted as encompassing a normal protein related to a disease. Somatostatin is a "pathogenic self protein" in view of its art recognized role in a variety of diseases (see Dean et al., column 2, first paragraph and column 6, third paragraph from bottom). Russell-Jones et al. do not teach use of immunodominant foreign T cell epitopes derived from diphtheria toxoid. Russell-Jones teach that immunodominant foreign T cell epitopes derived from diphtheria toxoid were known in the art (see page 4, first paragraph). Russell-Jones et al. teach that diphtheria toxoid has already been approved for use as a carrier for human vaccines (see page 14, first paragraph). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have created the claimed invention because Russell-Jones et al. teach the claimed method except for use of immunodominant foreign T cell epitopes derived from diphtheria toxoid, Russell-Jones et al. teach that immunodominant foreign T cell epitopes derived from diphtheria toxoid were known in the art and that diphtheria toxoid was already approved as a carrier for human vaccines. One of ordinary skill in the art would have been motivated to do so because immunodominant foreign T cell epitopes derived from diphtheria toxoid were known in the art and diphtheria toxoid was already approved as a carrier for human vaccines.

14. No claim is allowed.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ron Schwadron, Ph.D. whose telephone number is 571 272-0851. The examiner can normally be reached on Monday-Thursday 7:30-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571 272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application Number: 08/955,373

Art Unit: 1644

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



RONALD B. SCHWADRON
PRIMARY EXAMINER
GROUP 1800 (bwo)

Ron Schwadron, Ph.D.
Primary Examiner
Art Unit 1644